

REMARKS/ARGUMENTS

The Applicant thanks the Examiner for the Office Action dated December 12, 2007.

Claim Objections

Claim 1 has been amended to specify the step of “positioning the optically imaging pen operatively ...”, in accordance with the Examiner’s suggestion.

Claim 36 has been amended so as to include a colon

Claim Rejections – 35 USC § 112

Claim 1 has been amended to make it explicitly clear that the imaging pen is sensing the coincident coded data.

Claim 2 has been amended by replacement of the term “sensing device” with “imaging pen” so as to maintain consistency with claim 1.

Claim 47 has been cancelled.

Claim Rejections – 35 USC § 103

The Applicant contests the Examiner’s assertion that claim 1 is obvious in view of the combined teachings of Speiser and Cross.

The Examiner has relied upon the Speiser disclosure at page 6 in order to allege that certain features defined in claim 1 are taught by Speiser. In the Applicant’s submission, the following feature specified in claim 1 is not suggested anywhere in Speiser: “coded data indicative of a plurality of locations on the bill”. At page 6, last paragraph, Speiser teaches two different identification symbols i.e. bar code and/or magnetic characters and/or optical characters, or any other identification means readable by man or machine. Speiser teaches two different types of identification symbol, either of which arguably reads onto the Applicant’s “coded data indicative of an identity of the bill”. But there is nothing in Speiser that teaches “coded data indicative of a plurality of locations on the bill”. The second identification symbol taught by Speiser is evidently not an indication of a plurality of locations on the bill.

It is therefore clear that Speiser's system and the system as presently claimed are working in different ways. Whereas Speiser require two different identification symbols to be received in his computer system, the present invention requires a bill identity and a pen position.

The Examiner then alleges that Cross makes up for the shortcomings of Speiser. Cross describes a variant of an electronic digitizing pad. As explained on page 2, paragraph 2 of Cross, a user places paper on the electronic pad and writes on the paper. Electronic sensors in the underlying pad capture the positions of the pen, enabling the pad to generate digital ink representing movement of the pen. Although not explicitly stated in Cross, the electronic pad would use force sensors to detect the positions of the pen. Optical sensing would not, of course, be possible, because the pad is covered with paper.

By contrast, the present invention utilizes coded data printed on paper, and optical imaging of the coded data to determine positions of the pen and generate digital ink. Claims 1 and 29 now explicitly specify that the coded data is printed on the bill. Cross does not use optical imaging of printed coded data to generate digital ink.

In the Applicant's submission, the skilled person would not find any motivation to arrive at the present invention from the combined teachings of Speiser and Cross. From Speiser, he learns that he can determine a bill identity by swiping a standard barcode. From Cross, he learns he can generate digital ink when writing on paper by placing the paper on a specially-adapted pad comprising electronic sensors, which detect movement of the pen. Combining these two teachings would lead the skilled person to a system whereby he utilizes Cross's pad for the payment of bills by placing bill-payment sheets on the pad.

However, the Applicant submits that the teaching of Cross would not lead the skilled person to replace Speiser's barcode with printed coded data enabling the generation of digital ink in an optically imaging pen, which senses the coded data during handwritten input on the bill. The intellectual leap of replacing Speiser's barcode and replacing Cross's force-sensing electronic pad in this way would not have been within the ambit of the person skilled in the art, because it requires a fundamental change in the principle of operation of Cross's pad. In this regard, the Examiner is referred to MPEP 2143.01, wherein it is stated:

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are

not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)

Accordingly, it is submitted that the present invention is not obvious in view of Speiser and Cross.

It is respectfully submitted that all of the Examiner's objections have been successfully traversed. Accordingly, it is submitted that the application is now in condition for allowance. Reconsideration and allowance of the application is courteously solicited.

Very respectfully,

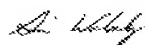
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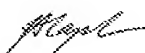
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